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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,329	11/14/2003	Hector Ray Hernandez JR.	9429	9489

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EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,329

Applicant(s)

HERNANDEZ, HECTOR RAY

Examiner

Michael W. Talbot

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-18 and 22-34 is/are allowed.
- 6) ☒ Claim(s) 6-8, 19-21 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plate member having at one end a pointed tip and a cut-a-way section" recited in claims 6 and 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The objection to the specification has been withdrawn due to Applicant's amendment filed 22 September 2005.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. With regards to claim 6, the phrase "said plate member having at one end a pointed tip and a cut-a-way section, said drill element being received in the cut-a-way section" is unclear as to the claimed limitations since the specific plate member construction is not supported by the specification/figures. Figures 6A-7B show the plate member (206,306) having two ends, a cutting end with a pointed tip (206a,306a) and an opposing end with a cut-a-way section (212,312). It is unclear as to how the pointed tip and the cut-a-way section can be both located at the same "one end" of the plate member.

Furthermore, the phrase "wherein the driver element has a diameter that is greater than a diameter of drill element and there is a cavity in one end of the driver element into which the drill element fits snugly" is unclear as to the claimed limitations when evaluated in combination with the above claimed phrase. Figures 6A and 6B show the driver element (204) having a diameter that is greater than a diameter of the drill element (202) and a cavity (210) in one end of the driver element into which the drill element fits snugly. It is unclear as to how the plate member with a pointed tip and a cut-a-way section both located at the same "one end" of the plate member can be assembled together with the driver and drill elements.

In conclusion, it is unclear as to where the combined structure recited in the above phrases is being shown or described in the specification and/or Figures. Specifically the pointed tip and cut-a-way section being on the same side of the drill plate wherein the drill element is being both received in the cut-a-way section of the plate member and the cavity of the driver element. Applicant's Response should provide the specific location(s) to the combined claimed

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structure from the specification and/or figures for clarity and understanding, without the introduction of "New Matter".

6. With regards to claim 7, the phrase "said plate member having at one end a pointed tip and a cut-a-way section, said drill element being received in the cut-a-way section" is unclear as to the claimed limitations since the specific plate member construction is not supported by the specification/figures. Figures 6A-7B show the plate member (206,306) having two ends, a cutting end with a pointed tip (206a,306a) and an opposing end with a cut-a-way section (212,312). It is unclear as to how the pointed tip and the cut-a-way section can be both located at the same "one end" of the plate member.

Furthermore, the phrase "wherein the drill element has a diameter that is greater than a diameter of driver element and there is a cavity in one end of the drill element into which the driver element fits snugly" is unclear as to the claimed limitations when evaluated in combination with the above claimed phrase. Figures 7A and 7B show the driver element (304) having a diameter that is greater than a diameter of the drill element (302) and a cavity (310) in one end of the drill element into which the driver element fits snugly. It is unclear as to how the plate member with a pointed tip and a cut-a-way section both located at the same "one end" of the plate member can be assembled together with the driver and drill elements.

In conclusion, it is unclear as to where the combined structure recited in the above phrases is being shown or described in the specification and/or Figures. Specifically the pointed tip and cut-a-way section being on the same side of the drill plate wherein the drill element is being received in the cut-a-way section of the plate member and having a cavity for receipt of the driver element. Applicant's Response should provide the specific location(s) to the combined claimed structure from the specification and/or figures for clarity and understanding, without the introduction of "New Matter"

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19 and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. '791 (formerly noted as Chen et al. 2004/0232631). Chen et al. '791 shows in Figures 6-11 a drill bit (50) having a drill element (54), a driver element (56) and a plate element (52) with a cutting end being axially aligned and assembled together with the plate member being intermediate the drill element and the driver element and with the cutting end of the plate element being adjacent to the drill element. Chen et al. '791 further shows both drill and driver elements having an elongated axial groove therein for receiving a portion of the plate member. Chen et al. '791 shows in Figures 1,3 and 11 a connect-disconnect coupling (20) having a spindle body (10) with an open mouth cavity (15) at one end and a slot (18) intersecting the longitudinal axis of the spindle body and the cavity, wherein the cavity is configured to receive the driver element of the drill bit.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. '791 (formerly noted as Chen et al. '2004/0232631) in view of Zierpka et al. '815. Chen et al. '791 is silent to the bonding mechanism used between the parts. Zierpka et al. '815 shows in Figures 5 and 6 that the connecting members (26,27) are positively engaged to an intermediate member (30). Zierpka et al. '815 further shows in col. 7, lines 11-13 that once assembled the parts can further be solidly joined. In view of this teaching of Zierpka et al. '815, it is considered to have been obvious to replace the engaging mechanism of Chen et al. '791 with another well-known, positively engaging mechanism of friction and/or alternate bonding.

Response to Arguments

9. Applicant's arguments filed 22 September 2005 have been fully considered but they are not persuasive.

Applicant's submitted Declaration is deemed insufficient as it lacks a required statement that the current application and the prior art reference (Chen et al. '791, formerly noted as Chen et al. '2004/0232631) "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person". Furthermore, the Declaration makes note through such statements as "was made known to us prior to the filing date" and "through this association we became aware of the invention disclosed in the Hernandez Application" that the prior art was known but fails to make any solid statements to the fact of common ownership at the time the later invention was made -- See MPEP 706.02(b); 706.02(f); 706.02 (l); 706.02(l)(1); 706.02(l)(2); 706.02(l)(3) --.

Allowable Subject Matter

10. Claims 6-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claim 9 is allowed.

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Chen et al. '791 (Patent of Chen et al. '2004/0232631) is the closest are of record.

Claim 9 is the independent claim. Chen et al. '791 lacks a cavity at one end of the drill or driver elements such that the other end of drill or driver element can be inserted into the cavity. There is no suggestion to modify Chen et al. '791 to include the cavity feature.

12. As previously indicated in Office Action dated 23 March 2005, claims 10-18 and 22-34 are allowed.

Chen et al. '2004/0232631 is the closest are of record.

Claims 10,11,22 and 30 are the independent claims. Regarding claim 10, Chen et al. '2004/0232631 lacks a cavity at one end of the drill and driver elements such that the other element can be inserted into the cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include the cavity feature.

Regarding claim 11, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element such that the drill element can be inserted into the driver cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include the cavity feature.

Regarding claim 22, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element, a groove at the same end intersecting the driver cavity and a longitudinal slot at the tapered end of the plate member. There is no suggestion to modify Chen et al. '2004/0232631 to include these features.

Regarding claim 30, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element and a groove at the same end intersecting the driver cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include these features.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



MWT
Examiner
8 January 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER